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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/201,867

11/30/1998

YUTAKA TAKAMI

HIT2944

2148

24956

7590

12/10/2007

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.

1800 DIAGONAL ROAD

SUITE 370

ALEXANDRIA, VA 22314

EXAMINER

GREENE, DANIEL LAWSON

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

12/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/201,867

Applicant(s)

TAKAMI ET AL.

Examiner

Daniel L. Greene Jr.

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-40 is/are pending in the application.
- 4a) Of the above claim(s) 36,37,39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-35 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20071010
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/2/2007 has been entered.

Response to Amendment

2. Applicant's amendment to the Abstract is acceptable and obviates the objection set forth in section 6 of the previous Office action mailed 5/2/2007. Accordingly said Objection is hereby withdrawn.

3. Applicants amendments to the drawings has obviated the objection set forth in section 7 of said previous Office action. Accordingly said Objection is hereby withdrawn.

Response to Arguments

4. **Applicant's arguments filed 8/2/2007 and 10/11/2007 have been fully considered but they are not persuasive.**

a. Applicant's arguments are unpersuasive as applicant has not shown that the references do not teach what the examiner has stated they teach, nor has applicant shown that the examiner's reasoning for and manner of combining the teachings of the references is improper or invalid.

b. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

c. Applicant argues that Jones et al. does not set forth a switching circuit as claimed and that Griffin and Nysen et al. fail to disclose such. The Examiner has shown in the previous Office action how the references read on the claimed invention. It appears that the novelty presented by applicant is in combining an IC card reader and modem and the "switch" that prevents the IC card from being directly connected to the external information processor. However, Jones Col. 4 lines 1-15 disclose various manners of reading the IC card and the use of a modem. There is no novelty in merely rearranging the various parts of an already operating system. Resort may be had to case law to show this. See for example, *In re Dulberg*, 129 USPQ 348, (CCPA 1961) "It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art" and *In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961)) "it would seem scarcely necessary to point out that merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable." In this case it appears that applicant has merely moved the switch from the modem to the terminal unit.

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d. Another way to look at this is to look at Figure 1 of the application as filed. Item 8 is a computer, Item 5 is an IC card reader and could stand alone, just like a credit card reader at a store, a multiport external modem would contain the switch, modem and control unit to determine which connected item gets access through the modem. A modem does not connect its multiple external connections to each other (that would be a network card or hub) instead it connects it's devices to telephone lines or cable lines, etc. Again, only one item can talk at a time, so the modem multiplexes the info, but does not directly connect its external devices to each other.

e. Again, it has been held obvious to integrate various devices without presenting a patentable invention when the end result is predictable and results in the same outcome. Accordingly it is considered obvious to combine a modem with an IC card reader for the benefits thereof, multipurpose device, shared tasks, etc.

The text of those sections of Title 35, U.S. Code not included in this action can be found
in a prior Office action.

Claim Rejections - 35 USC § 103

5. Claims 23-35 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,623,547 to Jones et al (Jones) in view of either

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U.S. Patent 5,666,402 to Griffin or U.S. Patent 5,164,985 to Nysen et al. (Nysen) for the reasons set forth in section 9 of the previous office action mailed 5/2/2007.

See further explanation in section 4 above.

6. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to claims 23-35 and 38 above in view of either U.S. Patent 4,092,580 to Prinsze and further or U.S. Patent 5,910,652 to Kuriyama for the reasons set forth in section 10 of the previous office action mailed 5/2/2007.

See further explanation in section 4 above.

Conclusion

7. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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